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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,618

05/21/2007

Roger Konig

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7590

06/25/2008

MYERS WOLIN, LLC

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1792

NOTIFICATION DATE

DELIVERY MODE

06/25/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@myerswolin.com

Office Action Summary	Application No. 10/596,618	Applicant(s) KONIG, ROGER	
	Examiner William P. Fletcher III	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 27, 29-33 and 36 is/are rejected.
- 7) ☒ Claim(s) 28, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 26-36 remain pending per the preliminary amendment filed June 19, 2006.
2. The Examiner notes that the above-mentioned preliminary amendment is not strictly compliant with 37 CFR 1.121 which requires that each amendment document that includes a change to an existing claim, cancellation of a claim, or submission of a new claim, *must* include a complete listing of all claims in the applications. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show current changes) *must* be presented. Any claim being canceled must be listed in the claim listing with the status identifier "canceled;" the text of the claim must not be presented. Providing an instruction to cancel is optional. All future amendments must include a claim listing with claims 1-25 identified as canceled.

Information Disclosure Statement

3. The information disclosure statement filed June 19, 2006, has been considered by the Examiner.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in

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upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD FOR PRODUCING CRACKED LACQUER STRCUTURE.

Claim Objections

5. Claims 26 and 33 are objected to because of the following informalities:

A. In claim 26, "abinder" should, apparently, read "a binder."

B. In claim 33

i. "terpealhydrocarbos" should, apparently, read "terpenealhydrocarbons;"

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- ii. “organometalic” should, apparently, read “organometallic;”
- iii. “nitrocallulox” should, apparently, read “nitrocellulose.”

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 26-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the second composition's comprising a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator, does not reasonably provide enablement for the any and all activators encompassed by the language of the claim. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. Claim 26

Applicant's broadest disclosure is of the second composition's comprising a low-viscosity commercially available glaze based on a water-soluble binder for wood sealing as an activator. This does not support the any and all activators encompassed by the claim limitation reciting a second composition comprising an activator. Possession of a species does not, necessarily, imply possession of the genus.

B. Claim 27

Similarly, Applicant's broadest disclosure is of the above-mentioned wood glaze, not the any and all glazes encompassed by this term, such as ceramic glazes.

C. Claim 28

Similarly, Applicant's broadest disclosure is of the above-mentioned wood glaze, not the any and all water-soluble acrylates encompassed by the claim limitation reciting a water-soluble acrylate.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 26-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 26

It is unclear what is meant by the composition's having a lacquer *and* a binder. The expected conventional recitation would be a lacquer *having* or *comprising* a binder. The Examiner has interpreted this claim as such.

B. Claim 30

The phrase "wherein the lacquer is a solvent" is indefinite. By definition¹, a lacquer *contains* a solvent, but also has other components. As such, the Examiner has interpreted this limitation as reciting that the lacquer *contains* or *comprises* a solvent.

C. Claim 31

The phrase “over in about 5 seconds” is incomprehensible. The Examiner has interpreted this limitation as reciting “for about 5 seconds.”

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 26, 27, 30, and 33, are rejected under 35 U.S.C. 102(b) as being anticipated by Thacker et al. (US 2,612,456 A).

A. Claim 26

Thacker teaches a process for the manufacture of an ornamental crackle coating on a substrate [1:1]. The process comprises the application of a first lacquer composition on a substrate, disclosed examples including nitrocellulose and acrylic resin binders [see 2:30 ff., for example]. The process further comprises the application of a second composition that forms a transparent, vinyl copolymer organosol [see 2:30 ff., for example]. Insofar as the organosol forms the crackle coating, it is the Examiner's position that this anticipates the claimed "activator." The first and second compositions are applied wet-on-wet [1:30-35]. Finally, the coated substrate is dried at elevated temperature (i.e., by heating) [see 2:30 ff., for example].

¹ See “lacquer” in *Hawley’s Condensed Chemical Dictionary*, 11th Ed., Copyright 1987 by Van Nostrand

B. Claim 27

Insofar as a "glaze" may be defined as "a thin topcoat of transparent paint used to modify the tone of the underlying color"² and the second coating composition of Thacker may be transparent, showing underlying detail [1:35-52], this coating anticipates the claimed "glaze."

C. Claim 30

Thacker teaches an acrylic resin dissolved in toluol [2:49].

D. Claim 33

As noted above, Thacker teaches, as the binder, acrylic resin (i.e., a synthetic resin of acrylic acid) and nitrocellulose [2:30 ff.].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 31, 32, and 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thacker et al. (US 2,612,456 A).

A. Claim 31

i. Thacker teaches various drying temperatures between about 150°F and 350°C (65.6°C and 176.7°C), but does not teach the claimed drying times.

Reinhold, page 679.

² See "glaze" in *The Oxford Dictionary and Thesaurus, American Ed.*, Copyright 1996 by Oxford University Press, Inc., page 622.

ii. It is the Examiner's position that drying time is a result-effective variable affecting the quality (uniformity, presence of defects, etc.) of the dried curing. Consequently, it would have been obvious to one skilled in the art to modify the process of Thacker to optimize this result-effective variable by routine experimentation. See MPEP 2144.05.

B. Claim 32

i. Thacker is silent with respect to the use of airflow during drying. Nevertheless, blowing or drawing air across an applied coating to promote drying is known in the art.

ii. The pressure at which the air is blown/drawn is also a result-effective variable, affecting drying time. Consequently, it would have been obvious to one skilled in the art to modify the process of Thacker to optimize this result-effective variable by routine experimentation. See MPEP 2144.05.

C. Claim 36

i. Thacker is silent with respect to the pH of the solution.

ii. Nevertheless, the pH of a coating solution is also a result-effective variable, particularly in resinous polymer systems, where pH affects polymer stability and reactivity. Consequently, it would have been obvious to one skilled in the art to modify the process of Thacker to optimize this result-effective variable by routine experimentation. See MPEP 2144.05.

14. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thacker et al. (US 2,612,456 A), as applied to claim 26 above, further in view of Inokami et al. (US 2003/0144455 A1).

A. As noted above, Thacker teaches that the lacquer may contain nitrocellulose (not soluble in water) or acrylic resin dissolved in toluol [2:30 ff.]

B. This reference does not expressly teach that the lacquer is water soluble.

C. Nevertheless, the binders disclosed by Thacker are merely exemplary and it is clear that any known, suitable binder may be utilized. It is known in the art to provide water-based formulations of acrylic resins in place of organic solvent-based formulations for environmental reasons. This is evidenced, for example, by Inokami at [0017].

D. Consequently, it would have been obvious to one skilled in the art to modify the process of Thacker so as to provide, as the acrylic resin lacquer, a water-based acrylic lacquer in place of the organic solvent-based lacquer for environmental reasons such as reduction of VOCs released on drying and the health and safety of workers.

Allowable Subject Matter

15. Claims 28, 34, and 35, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: Thacker is the closest prior art and is limited to the disclosed vinyl copolymer

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organosol. As such, use of a water-soluble acrylate, a soft lacquer, or a fragranced soft lacquer, are neither taught nor suggested.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,601,876 A; US 7,273,651 B1; JP 54-053152 A; and US 2,866,720 A; are cited as representative of the prior art. With respect to US 2,866,720 A, application of the crackle coating is to an underlying lacquer that has gelled and is "substantially immobilized," which does not read on the claimed requirement that the first coating be in a liquid state.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM; on campus every Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/

Primary Examiner

June 18, 2008